

REMARKS

Claim 46 has been amended to delete the term “about.” No new matter has been added. Applicants respectfully request entry of the above amendment, which raises no new issues that would require further consideration and/or search, and which places the application in better condition for allowance or appeal. Applicants respectfully request reconsideration and allowance of claims 24, 26-41, and 45-46 in view of the above amendment and following remarks.

Rejection under 35 U.S.C. §112, fourth paragraph

The Examiner rejected claim 46 under 35 U.S.C. §112, fourth paragraph, as allegedly failing to further limit the subject matter of a previous claim upon which it depends. While Applicants disagree with the Examiner, the term “about” has been deleted in claim 46 to expedite prosecution. The amendment to claim 46 does not affect the scope of this claim.

Rejection under 35 U.S.C. §103

The Examiner rejected claims 24, 26-41, and 45-46 under 35 U.S.C. §103 as being unpatentable over Wong (U.S. Patent No. 5,638,637) in view of McVetty (Can. J. Plant Sci. 76:343-344 (1996)) and further in view of Downey (Can. J. Plant Sci. 43:271-275 (1963)) in light of Siebel and Pauls (Theor. Appl. Genet. 77:489-494 (1989)). The Examiner asserted it would have been *prima facie* obvious to one of ordinary skill in the art to use the prior art high erucic acid line of Hero or Neptune in a cross with the high oleic acid line of Wong for the purposes of producing a variety of oil containing rapeseeds containing a range of both oleic acid and erucic acid. The Examiner also asserted that one skilled in the art would have been motivated to generate the claimed invention because both oils have commercial value as taught by Wong and Seibel and that one would have a reasonable expectation of success because methods of breeding for oil quality in rape were known in the art and because desired traits can be transferred using conventional plant breeding techniques as taught by Wong. In response to

Applicants' arguments, the Examiner asserted that usefulness of the oils is irrelevant and cited to *In re Kahn*, 441 F. 3d 977, 987, USPQ2d 1329, 1336 (Fed. Cir. 2006).

Applicants disagree.

As the Supreme Court recently clarified, obviousness under § 103 requires consideration of the factors set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), including an analysis of the scope and content of the prior art and the differences between the claimed subject matter and the prior art. An explicit rationale for why one having ordinary skill in the art would have combined the elements in the manner claimed must be set forth. Indeed, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" See, *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct 1727 (2007) (*quoting In re Kahn*, 441 F.3d 997, 988 (Fed. Cir. 2006)) (emphasis added). The Supreme Court noted that obviousness should be determined by a "common sense" approach ("[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it") (*KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1743 (2007)).

In the instant case, the cited references indicate that high erucic acid oils are useful as lubricants, whereas high oleic acid oils are useful as food oils. While lubricant oils and food oils may each independently have commercial value, the Examiner has not identified any rationale why one of ordinary skill in the art would produce plants that yield oil having a range of both erucic acid and oleic acid. In particular, the Examiner has not identified a rationale as to why one of ordinary skill in the art would cross a plant producing high erucic oil with a plant producing high oleic acid oil. Common sense would indicate that oil produced from a plant resulting from such a cross would be neither a good lubricant oil nor a good food oil. However, as indicated in the instant specification, the heterogeneous nature of the long chain monounsaturated fatty acids in the seed oil triacylglycerols surprisingly confers desirable properties to the oil, including desirable low temperature properties, oxidative stability, and high fluidity characteristics. See, page 18, lines 25-30 and page 20, lines 10-22 of the specification. Thus, the combination of cited references does not render the presently claimed methods obvious. The Examiner is requested to withdraw the rejection of claims 24, 26-41, and 45-46 under 35 U.S.C. §103.

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Serial No. : 10/715,100
Filed : November 17, 2003
Page : 8 of 8

Attorney's Docket No.: 07148-
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CONCLUSION

For at least the foregoing reasons, Applicants submit that claims 24, 26-41, and 45-46 are in condition for allowance, which action is respectfully requested. The Examiner is invited to telephone the undersigned agent at the telephone number below if such will advance prosecution of this application. Please apply the one-month extension of time fee and any other charges or credits, to deposit account 06-1050.

Respectfully submitted,

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